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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,944	08/30/2002	Dante Monteverde	33983/400100	3631
27717	7590	12/14/2004	EXAMINER	
SEYFARTH SHAW 55 EAST MONROE STREET SUITE 4200 CHICAGO, IL 60603-5803			NGUYEN, CINDY	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/064,944

Applicant(s)

MONTEVERDE, DANTE

Examiner

Cindy Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

This is in response to amendments filed 09/29/04.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 11, 12 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Klein et al. (US 6740729) (Klein).

Regarding claim 1, Klein discloses: method of predicting the search needs of a computerized database search user comprising the steps of: providing a topical category database (page 6, paragraph 0066, Klein), said topical category database containing a plurality of topical categories (404, fig. 4, Klein);

relating each of said topical categories with other said topical categories contained within said topical category database (fig. 1B and col. 3, lines 45-60, Klein);

providing a document database, said document database having document information for at least one document (col. 8, lines 34-55, Klein);

assigning each of said documents to at least one said topical category (col. 8, lines 9-12, Klein);

providing an anticipated search term database, said anticipated search term database having at least one anticipated search term (col. 3, lines 45-60, Klein);

assigning each of said anticipated search terms in said anticipated search term database to at least one said topical category thereby creating an anticipated search term assignment (fig. 1B and col. 3, lines 62 to col. 4, lines 6, Klein);

receiving at least one initial search term (col. 7, lines 64 to col. 8, lines 21, Klein);

matching said initial search term with at least one said anticipated search term contained within said anticipated search term database thereby creating a matched search term (col. 8, lines 34-55, Klein);

associating said initial search term to any topical categories related to said initial topical category thereby creating related categories (col. 3, lines 45-60, Klein);

associating said initial search term to any topical categories related to said initial topical category thereby creating related categories (col. 4, lines 17-25 and fig. 1B and fig. 8, Klein).

Regarding claim 2, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Klein discloses: further comprising the step of retrieving said document information of said documents assigned to said related categories (col. 4, lines 17-25 and fig. 1B and fig. 8, Klein).

Regarding claim 3, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Klein discloses: where each said topical category is defined with a title and description (col. 8, lines 10-12, Klein).

Regarding claim 4, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Klein discloses: wherein the step of relating each of said topical categories with other said topical categories contained within said topical category database further comprises the step of relating each of said topical categories with other relevant topical categories (col. 8, lines 34-55, Klein).

Regarding claim 5, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Klein discloses: wherein the step of relating each of said topical categories with other said topical categories contained within said topical category database further comprises the step of relating each of said topical categories with other related topical categories (col. 8, lines 34-55, Klein).

Regarding claim 6, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Klein discloses: wherein the step of relating each of said topical categories with other said topical categories contained within said topical category database further comprises the step of relating each of said topical categories with other adjunct topical categories (col. 12, lines 55 to col. 13, lines 8, Klein).

Regarding claim 7, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Klein discloses: wherein the step of assigning each of said documents to at least one said topical category further comprises the step of

assigning each of said documents to a relevant topical category (col. 5, lines 15-33, Klein).

Regarding claim 8, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Klein discloses: wherein the step of assigning each of said anticipated search terms in said anticipated search term database to at least one said topical category thereby creating an anticipated search term assignment further comprises the step of assigning each of said anticipated search terms to a topical category based on said anticipated search term's definition (col. 7, lines 64 to col. 8, lines 21, Klein).

Regarding claim 9, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Klein discloses: wherein the step of associating said initial search term with the topical category assigned to said matched search term thereby creating an initial topical category further comprises the step of calculating the most popular initial topical category for said matched search term (col. 8, lines 56 to col. 9, lines 54, Klein).

Regarding claim 11, all the limitations of this claim have been noted in the rejection of claim 9 above. In addition, Klein discloses: further comprising the step of calculating the number of times said initial search term is repeated within the content of said document assigned to said topical category (col. 8, lines 56 to col. 9, lines 54, Klein).

Regarding claim 12, all the limitations of this claim have been noted in the rejection of claim 9 above. In addition, Klein discloses: further comprising

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the step of subjectively determining said most popular initial topical category (col. 8, lines 56 to col. 9, lines 54, Klein).

Regarding claim 13, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Klein discloses: wherein said initial search term comprises at least one word (col. 3, lines 45-61, Klein).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klein (U.S. 6704729) in view of August et al. (US 6647383) (August).

Regarding claim 10, all the limitations of this claim have been noted in the rejection of claim 9 above. However Klein didn't disclose: wherein the step of calculating the most popular initial topical category for said matched search term further comprises the step of calculating the number of times a topical category is selected by other searchers in association with each said initial search term used. On the other hand, August discloses: wherein the step of calculating the most popular initial topical category for said matched search term further comprises the step of calculating the number of times a topical category is selected by other searchers in association with each said initial search term used (col. 8, lines 42-52, August). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the step of

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calculating the most popular initial topical category for said matched search term further comprises the step of calculating the number of times a topical category is selected by other searchers in association with each said initial search term used in the system of Klein as taught by August. The motivation being to enable the system provide the method for refine the importance of the data collected by counting of the number of users visiting a specific URL (col. 8, lines 42-52, August).

1. Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 571-272-4025. The examiner can normally be reached on M-F: 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CN

Cindy Nguyen

December 6, 2004

Frantz Coby
FRANTZ COBY
PRIMARY EXAMINER